

PATENT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

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Application Number : 10/628,702 Confirmation No. : 4056
Filed : July 28, 2003 Tech Cntr/AU : 3609
Attorney Reference : P-13001US (07093076) Customer Number : 26565
Examiner : Shahid Kamal
**Title : METHODS FOR PERFORMING TRANSACTIONS
IN A WIRELESS ENVIRONMENT**

**MAIL STOP APPEAL BRIEF
Commissioner for Patents
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APPEAL BRIEF

Sir:

This brief is submitted under 35 U.S.C. § 134 and is in accordance with 37 C.F.R. Parts 1, 5, 10, 11, and 41, effective September 13, 2004 and published at 60 Fed. Reg. 155 (August 2004). This brief is further to Appellant's Notice of Appeal, and in response to the Advisory Action dated April 17, 2008 for the above-identified application.

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(1) Real Party in Interest:

The real party in interest is Visa International Service Association.

(2) Related Appeals and Interferences:

No other appeals or interferences exist which relate to the present application or appeal.

(3) Status of Claims:

Claims 1-35 are pending, finally rejected, and appealed herein.

(4) Status of Amendments:

No amendments are outstanding.

(5) Summary of Claimed Subject Matter:

As an initial matter, it is noted that according to the Patent Office, the concise explanations under this section are for Board convenience, and do not supersede what the claims actually state, 69 Fed. Reg. 155 (August 2004), see page 49976. Accordingly, nothing in this Section should be construed as an estoppel that limits the actual claim language.

The invention generally pertains to performing transactions in wireless environments and for selecting the interface and application which will be used in the transaction. More specifically, the invention provides methods for utilizing an electronic device, such as an integrated circuit card, which is capable of communicating with for example a point of sale terminal across either a contactless wireless interface or a contact based interface employing physical contacts present on the card.

The invention enables selection of the interface and application to be used in the transaction, and informs the point of sale terminal of the appropriate data formats which will be used in the transaction. See for example paragraphs [0001] and [0012] of the specification for an overview (page 1 lines 3-9 and page 5 lines 14-22).

A plurality of embodiments are described in the specification, thus various portions of the specification may be cited for similar functionalities carried out by the different embodiments.

Claim 1 teaches a method of performing a transaction comprising:

- placing a first device in wireless communication with a second device (page 6 line 13, and page 9 line 4),**
- selecting an application deployed on the first device which will be utilized to conduct the transaction, wherein the application selected is supported by the second device (page 9 lines 15-19, page 11 lines 11-21, and page 13 lines 5-13),**
- determining transaction processing capabilities supported by the second device (page 11 lines 4-10, page 12 lines 15-16, and page 13 lines 5-13),**
- communicating application data from the first device to the second device, wherein the application data is selected in response to the transaction processing capabilities (Figure 2 item 220, page 12 lines 1-2, page 13 lines 1-2, and page 13 lines 16-17), and**
- processing the application data as required by the application to approve or disapprove the transaction (Figure 2 item 225, and page 15 lines 9-10).**

Claim 24 teaches a method for selecting an application for use in approving or disapproving a transaction over a wireless interface, comprising:

- transmitting the applications supported by a first device to a second device in wireless communication with the first device (Figure 4 item 405, page 11 lines 5-6, page 11 lines 14-16, and page 13 lines 7-13)**
- comparing the applications supported by the first device to applications supported by the second device (Figure 4 item 410, page 11 lines 7-8, and page 14 lines 9-10);**
- displaying on the second device the mutually supported applications to a user of the first device (Figure 4 item 415, page 11 lines 21-22, and page 12 lines 15-16);**
- selecting a desired application from the mutually supported applications displayed on the second device, wherein such selection is performed by the user of the first device (Figure 4 item 420, page 11 lines 21-22);**

- communicating the desired application from the second device to the first device (Figure 2 item 220, page 12 lines 1-2, and page 13 lines 1-2); and
- communicating from the first device to the second device data necessary for the desired applications to approve or disapprove the transaction (Figure 4 item 430, page 13 lines 1-2, and page 13 lines 16-17).

(6) Grounds of Rejection to be Reviewed on Appeal:

- (a) Whether claims 1, 4-6, 10, 14-15, 18-19, 24, 27-29, and 33 have been properly rejected under 35 U.S.C. § 102 (e) as anticipated by U.S. Patent Publication No. 2002/0152178A1 (Lee).*
- (b) Whether claims 2-3, 7-9, 13, 16, 20-23, 25-26, and 30-32 have been properly rejected under 35 U.S.C. § 103(a) as obvious in view of Lee and U.S. Patent Publication. No. 2002/0111919A1 (Weller).*
- (c) Whether claims 11-12, 17, and 34-35 have been properly rejected under 35 U.S.C. § 103(a) as obvious in view of Lee and U.S. Pat. No. 6,978,019B1 (Lapstun).*

(7) Argument:

- (a) Claims 1, 4-6, 10, 14-15, 18-19, 24, 27-29, and 33:*

It is noted that according to the Patent Office, a new ground of rejection in an Examiner's answer should be "rare" and should be levied only in response to such things as newly presented arguments by an Applicant or to address a claim that the Examiner previously failed to address, 69 Fed. Reg. 155 (August 2004), see, e.g., pages 49963 and 49980. Furthermore, a new ground of rejection must be approved by the Technology Center Director or designee and in any case must come accompanied with the initials of the conferees of the appeal conference, id., page 49979. Appellants note that the SPE signed off

on the final rejections. Accordingly it is not expected that reopening of prosecution will occur, since the SPE has already had the chance to consider the gravamen of the arguments below and has rejected them.

Claims 1, 4-6, 10, 14-15, 18-19, 24, 27-29, and 33 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Publication No. 2002/0152178A1 referred to hereafter as Lee. Appellants assert that Lee fails to teach or suggest numerous features claimed in the independent claims (1 and 24) as required for a valid anticipation rejection, and that the rejections of these claims and their dependent claims are therefore improper and should be reversed. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 UQPQ2d 1051, 1053 (Fed. Cir. 1987). The independent claims are now reviewed in view of the cited prior art.

Claim 1

Appellants highlight the claim 1 features of selecting, determining, and communicating, and note that these are described in the present specification in paragraph [0029] and paragraph [0030] for example, which state in part “Standard PPSE operates by the terminal requesting information on the applications supported by the card. The card responds with the AID's for the supported applications and priority indicators for each application. ... The terminal receives this information from the card and determines which of the applications supported by the card are also supported by the terminal. The terminal then selects the mutually supported application with the highest priority indicator as the application for use in the given transaction.” (page 11 lines 4-10).

In contrast, although Lee does describe a credit card transaction system with contactless communication (e.g. paragraph [0017] of Lee), Lee does not teach or suggest any of the highlighted aspects of claim 1. Indeed, not only the cited portions of Lee but all of Lee is entirely silent as to each of the highlighted features of claim 1. Lee does not teach selecting applications, either to determine if a contact-based or contactless transaction is occurring or for any other purpose, such as ensuring that applications for each transaction type are compatible on both devices and thus that subsequent application data will be successfully processed. Therefore, the rejection cannot stand.

Dependent claims 4-6, 10, 14-15, and 18-19, that depend on independent claim 1 above, are also not anticipated for the same reason provided for claim 1. These dependent claims are further patentable based on the additional limitations that are added by each such dependent claim.

Claim 24

Appellants highlight the claim 24 features of transmitting, comparing, displaying, selecting, and communicating the desired application, and note these are described in the present specification for example as described above regarding claim 1, but also in Figure 4, and paragraph [0012]. Paragraph [0012] particularly notes in part “In a preferred embodiment, the cardholder will select the payment service to be utilized in the transaction from a list of services mutually supported by the point of sale terminal on the contactless card.” (page 5 lines 20-22). See also paragraph [0031] which describes how an embodiment of the invention “allows the cardholder to make the selection of the application to be used in the transaction”. (page 11 lines 12-14 of the specification). Further steps are also delineated in paragraph [0031], including “the terminal requesting that the card...[identifies] the applications deployed on the card 400. The card transmits 405 this information over the wireless interface. ... The terminal then determines which of the applications supported by the card are also supported by the terminal 410. The mutually supported applications are then displayed to the cardholder 415 who selects the application to use in the transaction 420.” (page 11 lines 14-22).

In contrast, Lee neither teaches nor suggests any of these features. Indeed the underlying concept of the present invention described in paragraph [0011] of the specification is simply not considered by Lee at all: “a method for performing a transaction...wherein the electronic device and the point of sale terminal can exchange data across either a contactless interface or a contact based interface.” (emphasis added, page 5 lines 10-14). Lee simply doesn’t delve into the problems of ensuring the devices can properly process either type interface for a transaction at all, whether via an automated embodiment or one in which the user helps assure application compatibility. Therefore, reversal of the rejections is respectfully requested.

Dependent claims 27-29 and 33, that depend on independent claim 24 above, are also not anticipated for the same reason provided for claim 24. These dependent claims are

further patentable based on the additional limitations that are added by each such dependent claim.

(b) *Claims 2-3, 7-9, 13, 16, 20-23, 25-26, and 30-32:*

Claims 2-3, 7-9, 13, 16, 20-23, 25-26, and 30-32 were rejected as unpatentable over Lee in view of U.S. Pub. No. 2002/0111919A1 referred to hereafter as Weller. As noted above, independent claims 1 and 24, from at least one of which all these rejected claims depend, include highlighted elements neither taught nor suggested by Lee. Weller similarly fails to teach or suggest those elements as asserted. Instead, Weller is directed to a method for authenticating the identity of a cardholder during an online transaction, as noted in paragraph [0008] of Weller for example.

These rejected dependent claims are further patentable based on the additional limitations that are added by each such dependent claim. As the present invention includes features neither taught nor suggested by the cited prior art references, either separately or together, the obviousness rejections cannot be sustained. Mere untaught possibilities are insufficient to defeat patentability. A prior art reference must be considered in its entirety, i.e. as a whole. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)

Claim 13

Weller does not inform its first device of the application selected for use in performing the transaction as asserted, nor does Weller communicate a request seeking data on the capability of the second device to perform particular transaction types (e.g. contact-based or contactless). These distinctions are most apparent in claim 13 of the invention, so it is separately argued.

Therefore, reversal is respectfully requested.

(c) *Claims 11-12, 17, and 34-35:*

Claims 11-12, 17, and 34-35 are rejected as unpatentable over Lee in view of U.S. Pat. No. 6,978,019B1 referred to hereafter as Lapstun. As noted above, independent claims 1 and 24, on at least one of which all these rejected claims depend, include highlighted elements neither taught nor suggested by Lee. Lapstun similarly fails to teach or suggest

those elements. Instead, Lapstun is evidently directed to registering a user for use of a terminal of a computer system by using printed registration forms with invisibly printed indicia (claim 1). Therefore, reversal is respectfully requested. These dependent claims are further patentable based on the additional limitations that are added by each such dependent claim.

Appellants note that the portion of Lapstun cited for the rejection of claim 17 (column 21, lines 50-65) refers to handwriting recognition algorithms that can work with access only to a bitmap of pen markings. It is not clear to Appellants that handwriting recognition is at all analogous to the subject matter of the invention, which neither teaches nor claims handwriting recognition features per se.

Conclusion

For the reasons advanced above, Appellants assert the rejected claims are indeed patentable, thus the rejections should be reversed.

Respectfully submitted,

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APPENDIX A – APPEALED CLAIMS

1. A method of performing a transaction comprising:

placing a first device in wireless communication with a second device;

selecting an application deployed on the first device which will be utilized to conduct the transaction, wherein the application selected is supported by the second device;

determining transaction processing capabilities supported by the second device;

**communicating application data from the first device to the second device, wherein the application data is selected in response to the transaction processing capabilities;
and**

processing the application data as required by the application to approve or disapprove the transaction.

2. The method of claim 1 wherein the first device is an integrated circuit card.

3. The method of claim 2 wherein said integrated circuit card comprises an antenna for communicating with the second device over a wireless interface.

4. The method of claim 1 wherein the first device is a cellular telephone.

5. The method of claim 1 wherein the first device is a personal digital assistant.

6. The method of claim 1 wherein the first device comprises:

means for storing application data; and

means for communicating with the second device over a wireless interface.

7. The method of claim 1 wherein the second device comprises:

a reader for receiving data from the first device over a wireless interface.

8. The method of claim 1 wherein the second device comprises:

a point of sale terminal.

9. The method of claim 1 wherein the second device comprises a hardware security key.

10. The method of claim 1 wherein the first device communicates with the second device by radio frequency.

11. The method of claim 1 wherein the first device communicates with the second device by infrared communication.

12. The method of claim 1 wherein the first device communicates with the second device by laser communication.

13. The method of claim 1 wherein the step of determining transaction processing capabilities comprises:

informing the first device of the application selected for use in performing the transaction;

communicating a request from the first device to the second device wherein said request seeks data on the capability of the second device to perform particular transaction types; and

communicating the transaction processing capabilities from the second device to the first device.

14. The method of claim 1 wherein the application data comprises security data.

15. The method of claim 14 wherein the security data comprises data for static data authentication.

16. The method of claim 14 wherein the security data comprises data for dynamic data authentication.

17. The method of claim 1 wherein the step of processing the application data occurs offline.

18. The method of claim 1 wherein the step of selecting the application comprises:

transmitting from the first device to the second device a list comprising:

applications supported by the first device; and

a priority indicator for each application, wherein the priority indicator indicates the preference that the associated application will be selected for use in performing the transaction;

comparing the applications supported by the first device with the applications supported by the second device; and

selecting the application mutually supported by the first device and the second device with the highest priority indicator as the application for use in approving or disapproving the transaction.

19. The method of claim 1 wherein the step of selecting the application comprises:

transmitting from the first device to the second device data identifying the applications supported by the first device;

comparing the applications supported by the first device with the applications supported by the second device;

displaying applications mutually supported by the first device and the second device to a user of the first device; and

selecting the application to be used to approve or disapprove the transaction, wherein such selection is performed by the user of the first device.

20. The method of claim 1 wherein the second device is informed of the application data format prior to receiving the application data.

21. The method of claim 1 wherein the second device determines the application data format by parsing the application data for an indicator.

22. The method of claim 21 wherein the presence of the indicator informs the second device the application data is formatted for magnetic stripe transactions.

23. The method of claim 21 wherein the absence of the indicator informs the second device the application data is formatted for magnetic stripe transactions.

24. A method for selecting an application for use in approving or disapproving a transaction over a wireless interface comprising:

transmitting the applications supported by a first device to a second device in wireless communication with the first device;

comparing the applications supported by the first device to applications supported by the second device;

displaying on the second device the mutually supported applications to a user of the first device;

selecting a desired application from the mutually supported applications displayed on the second device, wherein such selection is performed by the user of the first device;

communicating the desired application from the second device to the first device; and

communicating from the first device to the second device data necessary for the desired applications to approve or disapprove the transaction.

25. The method of claim 24 wherein the first device is an integrated circuit card.

26. The method of claim 25 wherein said integrated circuit card comprises an antenna for communicating with the second device over a wireless interface.

27. The method of claim 24 wherein the first device is a cellular telephone.

28. The method of claim 24 wherein the first device is a personal digital assistant.

29. The method of claim 24 wherein the first device comprises:

means for storing application data; and

means for communicating with the second device over a wireless interface.

30. The method of claim 24 wherein the second device comprises:

a reader for receiving data from the first device over a wireless interface.

31. The method of claim 24 wherein the second device comprises:

a point of sale terminal.

32. The method of claim 24 wherein the second device comprises a hardware security key.

33. The method of claim 24 wherein the first device communicates with the second device by radio frequency.

34. The method of claim 24 wherein the first device communicates with the second device by infrared communication.

35. The method of claim 24 wherein the first device communicates with the second device by laser communication.

APPENDIX B – EVIDENCE

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978).

APPENDIX C – RELATED PROCEEDINGS

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978).